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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,311	04/26/1999	WILHELM GEIS	A90475	2136

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TIJERAS, NM 87059

EXAMINER

BONCK, RODNEY H

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/284,311	Applicant(s) GEIS ET AL.	
	Examiner Rodney H. Bonck	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following action is in response to the amendment received June 10, 2005.

Specification

The abstract of the disclosure is objected to because it exceeds the 150-word limit. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. There is no antecedent basis for "said steel member", line 4 of claim 27.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 18, 22, 24-26, 28-30, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hochmuth et al.('973). The Hochmuth et al. device comprises a spindle 10, a driven member 4, a freewheel having locking members 25, a ring 1 connected to the housing, a drive member 5 having unlocking members 27 (see Fig. 2), and torque transmitting catch surfaces formed by surfaces on projection 19 on the drive member and surfaces 28 on openings of the driven member. The catch openings are radial recesses (or "valleys") 22. The cams and locking members are arranged in pairs. Driven member 4 is force-lockingly connected to the spindle 10.

Claims 17, 18, 22, 24-26, 28-30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochmuth et al.(WO 96/20352 A1). The Hochmuth et al. device

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comprises a spindle 10, a driven member 4, a freewheel having locking members 25, a ring 1 connected to the housing, a drive member 5 having unlocking members 27 (see Fig. 2), and torque transmitting catch surfaces formed by surfaces on projection 19 on the drive member and surfaces 28 on openings of the driven member. The catch openings are radial recesses (or "valleys") 22. The cams and locking members are arranged in pairs. Driven member 4 is force-lockingly connected to the spindle 10.

Claims 17, 21-24, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwarzbich('479). The Schwarzbich device includes a spindle 26, a driven member 30, a freewheel having locking members 32, a ring 28, a drive member having unlocking members 36 and cams 38 that engage catch openings in the driven member. The catch openings are ring segments as seen in Fig. 2 of Schwarzbich.

Claims 17, 25, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ritter et al.('253). The Ritter et al. device comprises a spindle 27, a driven member 1,25 connected to the spindle, a freewheel having locking members 6,7, a ring 9 connected to the housing, and a drive member coaxially arranged to the spindle and provided with unlocking members 12a. The driven member and the drive member having torque-transmitting catch surfaces defined by surfaces 20,21 on cam surfaces of the drive member and surfaces 29,30 on catch opening in the driven member. Driven member 1 is shown as a sheet metal member. Reciting the method of making the driven member does not carry patentable weight in these claims to the locking device.

The Ritter et al. device further includes a closing member 15 that has clearance free contact with the driven member, since it is in fact formed integrally therewith, and has axial clearance relative to locking members 6 and 7 (see Fig. 2). A positive locking connection is provided between the driven member 1 and spindle 27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochmuth et al.('973) or Hochmuth et al.(WO 96/20352 A1) in view of Enzmann et al.('927). From Fig. 5 of either Hochmuth et al. document it appears that the drive

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member portion 9 is a toothed wheel. Furthermore, it would at least have been obvious to provide a toothed wheel or gear for the input to the device of Hochmuth et al. since such would be the obvious use of a notoriously old means for torque transmission.

While it would appear to be within the purview of the artisan to choose an appropriate material for the gear or toothed wheel, Enzmann et al discloses the use of plastic gears as claimed here. It would have been obvious to use plastic gears in the Hochmuth et al. device, the motivation being to take advantage of the light weight and reduced cost of plastic.

Response to Arguments

Applicants' arguments filed June 10, 2005 have been fully considered but they are not persuasive. Applicant maintains that the Hochmuth et al. patent was improperly applied under 35 USC 102(b). Upon closer inspection, however, it can be seen that Hochmuth et al. was applied under 35 USC 102(e) (see page 3 of the Office action of December 1, 1999). While applicant is correct that Hochmuth et al.('973) would not qualify as prior art under 35 USC 102(e) based on its PCT filing date, since it was not published in English, it does qualify under 35 USC 102(e) based on its "102(e) Date", which is the date that the conditions of 35 USC 371 were met and which also predates applicants' filing date. Additionally, the published PCT document has been obtained and is now applied. The WIPO publication date predates applicants' effective filing date of August 26, 1998 by more than a year and thus qualifies as prior art under 35 USC 102(b).

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Regarding Hochmuth et al. applicants further argue that the device is "a clamp-type locking mechanism". Whether this is true or not is immaterial since the Hochmuth et al. device meets the terms of the claims. Also, contrary to applicants' assertion, element 10 in Hochmuth et al. can be considered a spindle insofar as defined by the claims.

Regarding the rejection based on Schwarzbich, the statement of the rejection points out how the elements of the claim are met by the structure of Schwarzbich. Applicants have not pointed out what claimed element they believe is not met by the Schwarzbich device.

After reconsideration, the rejection based on Hochmuth et al. in view of Ritter et al. is withdrawn. The Ritter et al. device alone anticipates claims 17, 25, 27, and 31. Accordingly a new rejection has been made.

The reference to Cahill that was combined with Hochmuth et al. to meet claims 19 and 20 qualifies as prior art under 35 USC 102(e) absent a verified translation of the foreign priority document, since it was filed before applicants effective U. S. filing date of August 26, 1998. To obviate the need for such a translation, however, that rejection is withdrawn and a new reference (Enzmann et al.('927)) is applied to show that the use of plastic for gears is known and thus would not distinguish over the prior art.

Since new rejections have been made, this action is not a final action.

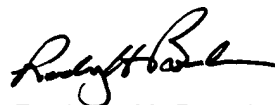
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (571)

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272-7089. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rodney H. Bonck
Primary Examiner
Art Unit 3681

rhb
July 18, 2005